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| 09/914,315 | 08/24/2001 | Jacques Sonzogni | 98ROI2954170 | 2214 |

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EXAMINER

PAIK, STEVE S

ART UNIT

PAPER NUMBER

2876

DATE MAILED: 12/02/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/914,315

Applicant(s)

SONZOGNI ET AL.

Examiner

Steven S. Paik

Art Unit

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 August 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 5-44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 37-39 and 41-44 is/are allowed.
- 6) ☒ Claim(s) 5-36 is/are rejected.
- 7) ☒ Claim(s) 40 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 October 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☒ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. Receipt is acknowledged of the Amendment filed on August 25, 2003. The Amendment includes newly added claims 37-44.

Claim Objections

2. Claim 40 is objected to because of the following informalities: the word "can not" in line 2 appears to include a typographical error. Appropriate correction is required.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 5-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Swartz (US 4,985,921) in view of Pockrandt et al. (US 5,678,027).

Re claims 5, 8, 14, 20, 23 and 29, Schwartz discloses a portable data carrying device (chip card 1) and a method for securing access to the device comprising a microprocessor (col. 2, ll. 42-45) including an operating system working with a set of instructions, said microprocessor (2, 2a-2c in Figs. 1-4) comprising a first register (one of slots in 10 or 10a in Fig. 3 and 4) for storing a first code (microcode) and a second register (15) for storing a second code for an application program (stored in the data memory 5) when a last call instruction was sent. The chip card further comprises a memory (5) connected to said microprocessor (2, 2a-2c) for storing

a plurality of application programs (data). The chip card provides a protection from unauthorized or unintended data modification by using a secure microcode signal (C).

While Schwartz teaches and fairly suggests an error checking mechanism using a special code (microcode) in a register in the field of a portable data-carrying device such as an integrated chip card, he is less explicit about a check bit included in the microcode within the register.

Pockrandt et al. discloses a method for preventing unauthorized modification of data in a portable device such as a chip card having a non-volatile memory, a central processing unit, and an error-checking device using a check bit in a check register. A check bit is set in a check register according to a command processed by a central processing unit (col. 1, ll. 61-67 and col. 2, ll. 1-15). Any data modification program takes place after the check process and a permission given afterwards. The check process undoubtedly prevents unauthorized and unintended data modification, which results in keeping a more secured portable data storage device.

In view of foregoing teachings, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to incorporate the check process, as taught by Pockrandt et al., into the chip card of Schwartz for the purpose of providing a checking device within a chip card to prevent an unauthorized or unintended data modification.

Re claims 6, 21 and 30, Swartz in view of Pockrandt et al. discloses the chip card and the method as recited in rejected claims 5, 20 and 29 stated above, where the microprocessor comprises a second register (15 in Fig. 4) for storing a second code for the application programs active when a last call instruction was sent.

Re claims 7, 15, 22 and 31, Swartz in view of Pockrandt et al. discloses the chip card and the method as recited in rejected claims 6, 14, 21 and 29 stated above, where the second register

cannot be directly accessed (the registers are coordinated with the microcodes of the control unit 2a).

Re claims 9, 10, 16, 17, 24, 25, 32 and 33, Swartz in view of Pockrandt et al. discloses a barrier logic circuit (SL in Fig. 1 of Pockrandt) which resets the processing unit as a function of the status of a check register (KR).

Re claims 11, 18, 26 and 34, Swartz in view of Pockrandt et al. discloses the first register is updated in response to the return instruction (col. 3, ll. 13-17).

Re claims 12, 27 and 35, Swartz in view of Pockrandt et al. discloses the chip card and the method as recited in rejected claims 5, 20, and 29 stated above respectively, where the checking device passes a control signal based on the status of check register (KR in Fig. 1 communicates with CPU) for providing access to the location of the memory (NVM) if the new entity is authorized.

Re claims 13, 19, 28 and 36, Swartz in view of Pockrandt et al. discloses the chip card and the method as recited in rejected claims 5, 14, 20 and 29 stated above, where the checking device (check register) checks and grants permission to modify data at a specific location of the memory after checking the status of the check register.

Allowable Subject Matter

5. Claims 37-39 and 41-44 are allowable.
6. Claim 40 would be allowable if rewritten to overcome the objection indicated above.
7. The following is a statement of reasons for the indication of allowable subject matter:
The cited prior arts of record, Schwartz (US 4,985,921); Pockrandt et al. (US 5,678,027) taken alone or in combination with other reference do not disclose, teach, or fairly suggest a chip card

comprising *inter alia* a microprocessor comprising a first register storing a first code, on at least one check bit, corresponding to a first application program to be executed from a plurality of application programs. If execution of the first application program needs intervention of a second application program, then the first application transmits a call instruction to the microprocessor requesting such intervention. Then, the first register is updated based on the call instruction for storing a second code, on the at least one check bit, corresponding to the second application program to be executed. Schwartz in view of Pockrandt discloses a special code for improving security of data within an IC card, which do not show the claimed features.

Response to Arguments

8. Applicant's arguments filed August 25, 2003 have been fully considered but they are not persuasive.

Rejections under 35 U.S.C. § 103(a)

Re claims 5-36, the applicant argues that the cited references do not teach a check bit used for checking whether access to locations in said memory is authorized for the new entity. The applicant further clarifies that the new entity is a new application program to be executed by the microprocessor (see page 13).

The examiner respectfully disagrees. Pockrandt et al. discloses a flow chart in Fig. 2 of the reference that comprises a step of checking a specific location in a memory (defined address region; col. 3, ll. 12-28). Unlike the applicant's argument, a specific region of memory is checked before a data modification is occurred. In other words, a data modification cannot be preformed until a check process to authorize a region of the memory takes place. Furthermore,

the phrase, "a new entity" may be replaced by -- a new application -- if the applicant intends to distinguishably recite the claimed invention.

Accordingly, the independent Claim 5 is interpreted as not patentable over the cited prior arts. The teachings of prior arts are applied to other independent Claims 14, 20 and 29 as well. Therefore, claims 5, 14, 20, and 29 and their dependent claims are rejected as discussed above.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven S. Paik whose telephone number is 703-308-6190. The examiner can normally be reached on Mon - Fri (5:30am-2:00pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on 703-305-3503. The fax phone numbers for the

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organization where this application or proceeding is assigned are 703-872-9306 for regular communications and 703-872-9306 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0530.

Steven Paik

Steven S. Paik
Examiner
Art Unit 2876

ssp
November 24, 2003


MICHAEL G. LEE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2800